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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,582	07/21/2003	James I. Livingstone	A894610US	3395

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EXAMINER
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COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/622,582

Applicant(s)

LIVINGSTONE, JAMES I.

Examiner

Giovanna M. Collins

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-172 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5-25,163-166 and 168-171 is/are allowed.
- 6) ☒ Claim(s) 26-64,68-72,74-82,86-88,90-98,100-119,121-152,154-162,167 and 172 is/are rejected.
- 7) ☒ Claim(s) 65-67,73,83-85,89,99,120 and 153 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/29/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20041129.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 26-27,29,32-34,37,43-44,146,151,152,155-158,162 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,8,19,27,31,39,40,42,43 of copending Application No. 10/346,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 26 -51, 98,100-119,121-148,150,152,154,156-157,159-162 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3,8, 14-21,23,28,30-46,51-54,64 of U.S. Patent No. 6854534. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the

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conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the Patent.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 52-55,59,60,75,77 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill 6,367,566.

Referring to claims 52 , 59,75, Hill discloses (see Fig. 1) an apparatus and a method for removing material from a well bore comprising delivering into said well bore a production tubing string (12), said tubing string comprising an inside and outside forming an annulus between the outside of the tubing string and a wall of said wellbore.; introducing into said well bore by a discharging means connected near the to top of the production string a pressurized clean out medium through one of the said inside production string and annulus removing said material and clean out medium through the other of the said inside of production tubing and the annulus to the surface of said well bore (col. 6, lines 46-61).

Referring to claims 53 and 60, Hill discloses a casing with perforations (col. 3, liens 60-63).

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Referring to claim 54, Hill discloses the clean out medium is introduced into the well at a pressure substantially equal to or below said pressure of the formation (col. 6, lines 62-65).

Referring to claims 55,77 Hill discloses the production string is a coiled tubing string (see col. 17, lines 1).

6. Claims 52,56-59,61,72,75,76,78,79 are rejected under 35 U.S.C. 102(b) as being anticipated by Arps 2,659,046.

Referring to claims 52 , 59,75,78 Arps discloses (see Fig. 1) an apparatus and a method for removing material from a well bore comprising delivering into said well bore a production tubing string (8), said tubing string comprising an inside and outside forming an annulus between the outside of the tubing string and a wall of said wellbore. introducing into said well bore by a discharging means (17) connected near the to top of the production string a pressurized clean out medium through one of the said inside production string and annulus and removing said material (at 4) and clean out medium through the other of the inside of production tubing and the annulus to the surface of said well bore.

Referring to claims 56 and 76, Arps discloses the production string (8) is a drill string.

Referring to claim 57, Arps discloses the material (at 1) comprises drilling fluids.

Referring to claim 58, Arps discloses the clean out medium (at 8) comprises drilling mud.

Referring to claims 61 and 79, Arps discloses the discharging means is a mud pump.

Referring to claim 72, Arps discloses the clean out medium (at 8) enters the inside of the production string and is removed through the annulus (at 1).

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7. Claims 52,56-59,61,72,75,76,78,79 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandvig 2,969,846.

Referring to claims 52 , 59,75,78 Sandvig discloses (see Fig. 1) an apparatus and a method for removing material from a well bore comprising delivering into said well bore a production tubing string (26), said tubing string comprising an inside and outside forming an annulus between the outside of the tubing string and a wall of said wellbore. introducing into said well bore by a discharging means (at 11) connected near the to top of the production string a pressurized clean out medium through one of the said inside production string and annulus and removing said material (at 18) and clean out medium through the other of the inside of production tubing and the annulus to the surface of said well bore.

Referring to claims 56 and 76, Sandvig discloses the production string (26) is a drill string.

Referring to claims 68-70 and 86-88, Sandvig discloses a reciprocating clean out tool with a plurality of teeth and a reciprocating piston (col.1, lines 15-18)

Referring to claim 71, Sandvig discloses the clean out medium enters the annulus (at 25) of the production string and is removed through the inside of the production string (at 29).

8. Claims 75,77,91-93, and 96-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolle 6,347,675.

Kolle discloses (see Fig. 4) an apparatus for removing material from a well bore comprising a production tubing string (12), said tubing string comprising an inside and outside forming an annulus between the outside of the tubing string and a wall of said wellbore;

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introducing into said well bore by a discharging means (36) connected near the to top of the production string a pressurized clean out medium through one of the said inside production string and annulus removing (at 22) said material and clean out medium through the other of the said inside of production tubing and the annulus to the surface of said well bore.

Referring to claim 77, Kolle discloses the production string (12) is coiled tubing.

Referring to claim 91, Kolle discloses an downhole assembly (26,28).

Referring to claim 92, Kolle discloses a reciprocating clean out tool (28).

Referring to claim 93, Kolle discloses a rotating means (26).

Referring to claims 96-97, Kolle discloses a work reel (14) for storing the coiled tubing.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 62 and 80 rejected under 35 U.S.C. 103(a) as being unpatentable over Sandvig '846 in view of Kunnemann '618.

Referring to claims 62 and 80, Sandvig does not disclose the discharge medium is a discharging compressor. However, Sandvig does disclose the clean out medium is pressurized air (col. 2, lines 35-36). Kunnemann teaches using a compressor to supply compressed air to a production string. As one of ordinary skill in the art would be familiar with the use of a

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discharging compressor to supply compressed air, it would be obvious to one of ordinary skill in the art at the time of the invention to modify method and apparatus disclosed by Sandvig to have a discharging compressor as taught by Kunnemann.

11. Claims 63-64 and 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandvig '846 in view of Sinclair '515.

Referring to claims 63 and 81, Sandvig does but does not disclose a suctioning means. Sinclair teaches (see Fig. 1) using a suction compressor to help remove a cleanout fluid (see col. 2, lines 59-60). As it would be advantageous to have a suction compressor to help the cleanout medium remove the material, it would be obvious to modify Sandvig to have a suction compressor as taught by Sinclair.

Referring claims 64 and 82, Sinclair teaches a suction compressor (see col. 2, lines 59-60).

12. Claims 74, 90, 167, and 172 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandvig '846 in view of Gardes 5,720,356.

Referring to claims 74, 167, 172, Sandvig discloses (see Fig. 1) an apparatus and a method for removing material from a well bore comprising delivering into said well bore a production tubing string (26), said tubing string comprising an inside and outside forming an annulus between the outside of the tubing string and a wall of said wellbore. introducing into said well bore by a discharging means (at 11) connected near the top of the production string a pressurized clean out medium through one of the said inside production string and annulus and



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removing said material (at 18) and clean out medium through the other of the inside of production tubing and the annulus to the surface of said well bore but does not disclose sending hydrocarbons to the flare. Gardes teaches sending hydrocarbons to the flare (fig. 7a, at 89). AS it would be advantageous to have a way of disposed of hydrocarbons that cannot be reused, it would be obvious to one of ordinary skill in the art to modify the apparatus and method disclosed by Sandvig to include a flare as taught by Gardes.

13. Claims 94-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolle '675 in view of Smet '223.

Kolle does not specifically disclose connecting and disconnecting means between the coiled tubing and the clean out tool. Smet teaches (fig. 1) connecting means and disconnecting means (at 25 and 26). As it would be advantageous to have a way to easily remove the clean out tool if it needs replacement, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus disclosed by Kolle to have connecting means and disconnecting as taught by Smet.

*Allowable Subject Matter*

14. Claims 1, 5-25, 163-166, and 168-171 are allowed.

15. Claims 65-67, 73, 83-85, 89, 99, 120, and 153 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

16. Applicant's arguments filed 11/29/04 have been fully considered but they are not persuasive. The application claim limitations although broader are not patentably distinct from the claims disclosed in the Livingstone '534 patent and Application 10/346125.

17. Applicant's arguments with respect to claims 52-64,68-72,74-82,86-88,90-97 167,172 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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